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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,219

Applicant(s)

ROSENOFF ET AL.

Examiner

Maikhanh Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,14,15,17,19-49 and 64-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,14,15,17,19-49 and 66-69 is/are rejected.
- 7) ☒ Claim(s) 64 and 65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/20/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 12/20/2004 to the application filed 01/25/1999; IDS filed 12/20/2004.
2. Claims 1-9, 14-15, 17, 19-49 and 64-69 are currently pending in this application. Claims 10-13, 16, 18, and 50-63 have been cancelled. Claims 65-69 have been added. Claims 1-6, 14, 17, and 22-23 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-9, 14, 17, 19-26, 28, 31-38, 42-49, and 66-69 are rejected under 35

U.S.C. 103(a) as being unpatentable over **Sotomayor** (U.S. 5,708,825 – filed 05/1995) in view of **Kanoh et al.** (U.S. 5,873, 077 – filed 04/1996).

As to independent claim 17:

- a. Sotomayor teaches a method of automatically inserting hyperlinks into a document (*Abstract*), comprising:
 - (i) searching one or more documents (*e.g., scanning one or more documents...select source documents; Abstract*);
 - (ii) automatically marking one or more portions of one or more of the searched documents based on results of searching the one or more documents (*e.g., automatically identifies significant key topics within the selected document; Abstract/ col.4, lines 24-30*); and
 - (iii) inserting one or more hyperlinks into one or more of the documents (*e.g., embeds hyperlinks from these summary pages to the locations where key topics appear in the presentation pages; Abstract*) with each hyperlink having a URL including a domain name identifying a computerized service for use in conducting a search based on the included portion (*e.g., www.myserver.com; col.11, lines 9-18*).
- b. Sotomayor does teach each hyperlink having a URL including a domain name identifying a computerized service, but is silent on “a URL including at least a portion of one of the marked portions.”
- c. Kanoh teaches each hyperlink having a URL including at least a portion of one of the marked portions (*col.5, lines 27-56 and col.8, lines 53-64*).
- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor

because it would have provided the capability for efficiently performing a search based on search terms on the searched documents.

As to dependent claims 42-43:

Sotomayor teaches searching the one or more documents comprises searching for citations to other documents (*e.g., At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17*).

As to dependent claim 44:

Sotomayor teaches searching the one or more documents comprises searching for proper names (*Abstract*).

As to dependent claim 45:

Sotomayor teaches one or more of the marked portions include a citation to a document, with the citation include a page identifier and publication identifier; and at least one of the hyperlinks include the page and publication identifiers (*e.g., automatically identifying significant key topics, concepts, and phrases in the documents; Abstract*).

As to dependent claim 46:

- a. Kanoh teaches one or more of the generated hyperlinks includes at least one query connector (*col.8, lines 53-64*).
- b. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claim 47:

- b. Kanoh teaches at least one of the hyperlinks identifies one of a natural-language search method and a Boolean search method (*col.9, lines 38-50*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claim 48:

Sotomayor teaches each hyperlink further includes account information for a user (*e.g., www.myserver.com/user1; col.11, lines 9-18*).

As to dependent claim 49:

Sotomayor teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (*col.14, lines 31-51*).

As to independent claim 1:

The rejection of independent claim 17 above is fully incorporated herein. Additionally, Sotomayor further teaches receiving one or more documents (*e.g., scanning one or more documents; Abstract*).

As to dependent claim 19:

Sotomayor teaches the one or more predefined forms includes citations to printed publication (*e.g., At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17*).

As to dependent claim 20:

Sotomayor teaches one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and publication identifier, and wherein at least one of the generated hyperlinks includes volume, page, and publication identifiers (*e.g., automatically identifying significant key topics, concepts, and phrases in the documents; Abstract*).

As to dependent claim 25:

Sotomayor teaches one or more of the hyperlinks further includes account information for a user (*e.g., www.myserver.com/user1; col.11, lines 9-18*).

As to dependent claim 26:

Sotomayor teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (*col.14, lines 31-51*).

As to independent claim 2:

The rejection of independent claim 17 above is fully incorporated herein. Additionally, Sotomayor further teaches generating one or more hyperlinks (*e.g., automatically generated hyperlinks; Abstract*).

As to independent claim 3:

It is directed to a computer system for performing the method of claim 17, and is similarly rejected under the same rationale.

As to independent claim 4:

It is directed to a computer system for performing the method of claim 17. Additionally,

Sotomayor further teaches a processor (*col.5, lines 53-67*) and a memory (*col.5, lines 53-67*).

As to independent claim 5:

It is directed to a computer-readable medium for implementing the method of claim 17, and is similarly rejected under the same rationale.

As to independent claim 6:

- a. Sotomayor teaches an automated method of defining hyperlinks for a documents (*Abstract*), comprising:
 - (i) automatically marking one or more portions of the documents (*e.g., automatically identifying significant key topics ... in the documents; Abstract*); and
 - (ii) defining one or more hyperlinks for one or more of the marked portions of the document (*e.g., embeds hyperlinks from these summary pages to the locations where key topics appear in the presentation pages; Abstract*), with each hyperlink having a URL including a domain name identifying a computerized service for use in conducting a search based on the included portion (*e.g., www.myserver.com; col.11, lines 9-18*).
- b. Sotomayor does teach “each hyperlink having a URL including a domain name identifying a computerized service, but is silent on “a URL including at least a portion of one of the marked portions.”
- c. Kanoh teaches each hyperlink having a URL including at least a portion of one of the marked portions (*col.5, lines 27-56 and col.8, lines 53-64*).

- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because it would have provided the capability for efficiently performing a search based on search terms on the searched documents.

As to dependent claim 7:

Sotomayor teaches each hyperlink further includes account information for a user (*e.g.*, *www.myserver.com/user1*; *col.11, lines 9-18*).

As to dependent claim 8:

Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks (*e.g.*, *www.myserver.com/user1*; *col.11, lines 9-18*).

As to dependent claim 9:

Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks and information based on a syntactic or semantic analysis of at least a portion of one of the marked portions of the document (*e.g.*, *key-topic entries are key concepts and associated hyperlinks that were automatically generated from source documents... identify particularly high semantic weight key words; col.14, lines 52-59*).

As to independent claim 14:

The rejection of independent claim 17 above is fully incorporated herein. Additionally, Sotomayor further teaches associating the defined hyperlink with the marked portion of the first document (*e.g.*, *embeds hyperlinks from these summary pages to the locations where key topics appear; abstract*).

As to dependent claim 31:

Sotomayor teaches one of two or more destinations is within the computer system and another of the two or more destinations is without the computer system (*e.g., hyperlink destinations; col.9, lines 11-45*).

As to dependent claim 32:

It includes the same limitations as in claim 20, and is similarly rejected under the same rationale.

As to dependent claim 33:

It includes the same limitations as in claim 46, and is similarly rejected under the same rationale.

As to dependent claim 34:

- a. Kanoh teaches hyperlink further includes at least one search instruction (*col.10, lines 8-26*).
- b. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claims 35- 37:

They include the same limitations as in claims 24-26, and are similarly rejected under the same rationale.

As to dependent claim 38:

Sotomayor teaches associating the hyperlink with the marked portion includes associating the hyperlink with at least two marked portions (*col.3, line 63- col.4, line 8 and; col.4, lines 24-45*).

As to independent claim 21:

- a. The rejection of independent claim 17 above is fully incorporated herein.

Additionally, claim 21 further recites “one or more of the generated hyperlinks includes at least one query connector.”
- b. Kanoh teaches one or more of the generated hyperlinks includes at least one query connector (*col.8, lines 53-64*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claim 22:

It includes the same limitations as in claim 34, and is similarly rejected under the same rationale.

As to dependent claim 69:

Sotomayor teaches the searching, marking, and generation occur in response to user operation of a document-processing application having an active edit window containing one of the documents (*col.34, lines 15-36 & lines 50-57*).

As to independent claim 23:

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- a. The rejection of independent claim 17 above is fully incorporated herein.
Additionally, claim 23 further recites “one or more of the generated hyperlinks including a search-method identifier.”
- b. Kanoh teaches one or more of the generated hyperlinks further includes a search-method identifier (*e.g., the query created ... a http query ‘e.g., a URL’ an identifier of one or more characters; col.8, lines 53-64*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature of Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to dependent claim 24:

- a. Kanoh teaches the search-method identifier identifies one of a natural-language search method and a Boolean search method (*col.9, lines 38-50*).
- b. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Kanoh in the system of Sotomayor because it would have provided the capability for identifying the search term locations, regardless of whether such documents are search forms.

As to independent claim 66:

The rejection of independent claim 17 above is fully incorporated herein. Additionally, Sotomayor further teaches in response to user operation of a document-processing application having an active document in an active edit window associated with the document-processing application (*e.g., a word-processing program which, when active*

by the user; col.34, lines 58-60), automatically marking one or more citations to the legal documents that are in active document (col.34, lines 58-67 & col.35, lines 29-30).

As to dependent claim 67:

Sotomayor teaches the document-processing application includes at least one of a word-processing application (*e.g., word-processor program; col.34, lines 15-57*), a spreadsheet application, and a presentation-development programs.

As to dependent claim 68:

Sotomayor teaches the document-processing application includes a version of Microsoft Word (*e.g., word-processor program; col.34, lines 15-57*) or Corel WordPerfect.

5. Claims 15 and 29-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Sotomayor** in view of **Kanoh et al.** as applied to claim 14 above, and further in view of **Rodkin et al.** (U.S. 6,092,074 – filed 02/1998).

As to dependent claim 15:

- a. The combination of Sotomayor and Kanoh does not explicitly teach “*one or more user preferences includes information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and wherein defining the hyperlink includes selecting the one destination based on the retrieved preferences.*”
- b. Rodkin teaches one or more user preferences includes information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and wherein defining the hyperlink includes

selecting the one destination based on the retrieved preferences (*e.g., Destination preferences 568 may influence the destination decision filter 565 so that preferred addresses are selected. For example, particular destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).*

- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 29:

- a. The combination of Sotomayor and Kanoh does not explicitly teach "the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost."
- b. Rodkin teaches the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost (*e.g., Destination preferences 568... destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).*
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a

Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 30:

- a. The combination of Sotomayor and Kanoh does not explicitly teach “the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time.”
- b. Rodkin teaches the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time (*e.g., The preference criteria may designate a particular type of web site... which the candidate destination addresses are obtained; col.12, lines 18-28*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Rodkin’s teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

6. Claims 27-28 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sotomayor** in view of **Kanoh et al.** as applied to claims 1 and 17 above, and further in view of ~~Wolfe~~ (U.S. 6,263,351 – filed 02/1998, Continuation of application No. 09/014,669 – filed 01/1998), as cited by Applicant in IDS, filed 04/12/2004.

As to dependent claim 27:

- a. Sotomayor teaches inserting one or more hyperlinks (*e.g., embeds hyperlinks from these summary pages to the locations where key topics appear in the presentation pages; Abstract*), but is silent on “changing font color associated with one of the marked portions.”
- b. Wolfe teaches changing font color associated with one of the marked portions (*a marker on ... highlighting can be done by changing the color ...which cases have been viewed; col.10, lines 15-34 and Fig.7D*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Wolfe’s teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability for allowing the user to determine, by looking at each presentation, those which he or she has studied or already displayed. Such highlight provides a means by which user will know when he or she has looked at all the citing cases.

As to dependent claim 28:

Refer to discussion of claim 27 above for the rejection.

As to dependent claim 39:

It includes the same limitations as in claim 27, and is similarly rejected under the same rationale.

As to dependent claim 40:

- a. The combination of Sotomayor and Kanoh does not explicitly teach “changing the font associated with one of the marked portions comprises underscoring the one of the marked portions.”

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- b. Wolfe teaches changing the font associated with one of the marked portions comprises underscoring the one of the marked portions (*col.10, lines 15-34 and Fig.7D*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Wolfe's teaching in the system of Sotomayor as modified by Kanoh because it would have provided the capability allowing the user to determine, by looking at each presentation, those which he or she has studied or already displayed. Such highlight provides a means by which user will know when he or she has looked at all the citing cases.

As to dependent claim 41:

Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes anchoring at least one of the generated hyperlinks to at least one of the marked portions (*e.g., inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45*).

Allowable Subject Matter

- 7. ~~Claims 64-65 are objected to as being dependent upon a rejected base claim, but would~~
be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 12/20/2004 have been fully considered but they are not persuasive.

Applicant argues that there *The Action fails to cite any objective evidence to support this proposed combination...the Examiner must provide some objective teaching or suggestion in the art to support the combination.* (Remarks, page 13)

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a

particular reference. See *In re Bozek*, 163 USPQ 545 (CCPA) 1969. Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See *In re Bode*, 193 USPQ 12 (CCPA 1977).

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
May 2, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER